

39. (Amended) A stereographic device comprising:

a content support portion having stereographic content which includes a left peripheral monocular field, a left binocular stereo field, a right binocular stereo field, and a right peripheral monocular field;

a stereoscopic viewer including adjustable left and right lenses and left and right adjustable occluding apertures associated with the left and right lenses, respectively, the viewer being configured so that content of the left binocular stereo field is visually merged with content of the right binocular stereo field to enable perception of three fields of content including the left and right peripheral monocular fields of two dimensional content and a central binocular stereo field of three dimensional content located therebetween; and

a viewer pivotal chassis configured to couple the viewer to the content support portion.

20. 42. (Amended) The apparatus of claim 39, wherein the viewer pivotal chassis is configured to enable said viewer to be positioned in alignment with said content support portion and said content to facilitate perception of said content, the viewer pivotal chassis being configured to enable a distance between said viewer and said content to be adjustable to facilitate focalization and configured to enable the viewer to be moveable in a plane that is parallel to a plane of said content so that said content is visually scannable with said viewer by moving said viewer in said plane up and down a length of said content while maintaining focus.

#### REMARKS

Claims 33 and 34 have been amended to depend from independent claim 22. Therefore, Applicant submits that the examiner's rejections of claims 34, 35 and 36 under 35 U.S.C. §112, first paragraph, are overcome by these amendments. The examiner has also amended claims 22, 23, 26, 28, 30, 31, 34, 39 and 42 to delete the words "user" and "can" from the claims. Applicant respectfully requests withdrawal of the rejections of claims 22-42 under 35 U.S.C. §112, second paragraph.

Applicant acknowledges with appreciation the examiner's indication that claim 28 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph, and amended into independent form. Therefore, Applicant submits that claim 28 is in condition for allowance. Such action is respectfully requested.

The examiner rejected claims 22, 29, 31, 37, 39 and 42 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 174,893 to Bierstadt in view of Japanese Patent Document No. 63-8624 to Kono and U.S. Patent No. 1,186,786 to Huber et al.

### Arguments

#### I. The Examiner's Rejections Under 35 U.S.C. §103 Are Not Proper.

##### A. Legal Analysis of 35 U.S.C. §103 Rejections

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. Section 103(a); see Graham v. John Deere Co., 383 U.S. 1, 14, 148 USPQ 459, 465 (1966). "The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness." In re Dembiczak, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all the claim limitations. M.P.E.P. § 2143.

When combining the content of various references, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." In re Dance, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Raynes, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Accord, In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

A proper analysis further requires considering “whether the prior art would also have revealed that in [making the claimed invention], those of ordinary skill in the art would have a reasonable expectation of success.” In re Vaeck, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). “Obviousness cannot be established by hindsight combination to produce the claimed invention.” In re Dance, 48 USPQ2d at 1637; In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). “Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” ATD Corp. v. Lydall Inc., 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

Finally, “both the suggestion and the reasonable expectation of success must be founded in the prior art, and not in the applicant’s disclosure.” In re Vaeck, 20 USPQ2d at 1442. “[I]t is the prior art itself, and not the applicant’s achievement, that must establish the obviousness of the combination.” In re Dance, 48 USPQ2d at 1637; Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985).

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” In re Dembiczak, 50 USPQ2d at 1617; Feil, 227 USPQ at 547 (Fed. Cir. 1985). The prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); M.P.E.P. § 2141.02.

In a 1999 Federal Circuit case, In re Dembiczak, the Federal Circuit reversed a finding of obviousness made by the Board of Patent Appeals because “the Board fell into the hindsight trap.” In re Dembiczak, 50 U.S.P.Q.2d at 1617. The patent-at-issue related to a decorative bag wherein “[a]ll of the independent claims on appeal . . . contain limitations that the bag must be ‘premanufactured orange in color,’ have ‘facial indicia,’ have openings suitable for filling with trash material, and that when filled, the bag must have a generally rounded appearance, like a pumpkin.” *Id.* at 1615. The prior art included conventional trash bags, books for teachers describing how to make paper bag pumpkins, and design patents depicting bags having jack-o’-lantern faces. *Id.*

The Federal Circuit emphasized the importance that the prior art references teach or suggest that their combination yield the claimed invention.

[T]he obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. For example, the Board finds that the Holiday bag reference depicts a 'premanufactured orange' bag material, . . . finds that Shapiro teaches the use of paper bags in various sizes, including 'large', . . . and concludes that the substitution of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an obvious choice. . . . Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention.

Id. at 1618 (citing In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998)).

B. Independent Claims 22 And 39 Are Patentable Over Bierstadt, Kono and Huber Under 35 USC §103(a).

1. The Scope And Content Of The Prior Art

The cited references also are discussed in detail in Exhibit B attached hereto. Bierstadt discloses a stereoscope having a double flap A, B attached to the front cover. In the outer flap B, two prismatic lenses (a) are set about 2 1/2" apart from center to center. Abutting pictures are located opposite from the lenses (a).

As discussed below with reference to Exhibit B, Figs. 1, 2 and 4 of Kono illustrate images which are separated from each other by a 23 mm gap and are designed to be free-viewed together to form a wide angle two dimensional image. Figs. 3 and 4 illustrate a strip of film used to take the images. Items 3 and 3a are the same camera lens illustrated as the film moves through the camera in time. Frame 7 is exposed first, then the film is advanced to the left frame 7a, another picture is taken. The lenses 3, 3a are actually the same camera lens at different points of time. The viewer in Kono is illustrated with reference to Figs. 5-9.

Huber discussed in detail below in Exhibit B discloses stereoscopic glasses having ear engaging members 24 to hold the glasses on a person's head. Lenses 13 and 14 are mounted in frames 11 and 12, respectively. Shields 15 and 16 are carried by frames 11 and 12 and are disposed inwardly of the lenses 13 and 14, respectively. Lenses 13 and 14 are adjustable toward and away from each other using rotating rod 5.

2. Claims 22 and 39

i. The Differences Between The Claimed Invention And The Prior Art

The examiner admits that Bierstadt does not disclose or suggest a content portion which includes a left peripheral monocular field, a left monocular stereo field, a right monocular stereo field, and a right peripheral monocular field as claimed in claims 22 and 39. The examiner also admits that Bierstadt does not disclose or suggest a viewer having adjustable left and right lenses and left and right occluding apertures that enable the content to be visually merged as claimed.

Kono does not disclose or suggest a viewer having adjustable left and right lenses and left and right occluding apertures as claimed. Kono also does not disclose or suggest that the lenses can be adjusted to visually merge the content to provide left and right peripheral monocular fields of two dimensional content and central monocular stereo field of three dimensional content as claimed. In addition, Kono does not disclose or suggest a viewer pivotal chassis for coupling the content to a viewer as claimed. Kono provides a 23mm gap between images so that the images can be free viewed or view with a magnifying lens and shown Fig. 9.

Huber does not disclose or suggest a content portion or all, let alone a content portion which includes a left peripheral monocular field, a left monocular stereo field, a right monocular stereo field, and a right peripheral monocular field as claimed in claim 22 and 39. Huber does not disclose that the left and right lenses and left and right occluding apertures are adjustable to visually merge the content to enable perception of three fields as claimed. In addition, Huber does not disclose or suggest any type of viewer pivotal chassis to couple the viewer to the content portion. Instead, Huber discloses only a pair of glasses to wear on the user's face.

ii No Suggestion, Motivation, Or Teaching Is Present to Support the Combination of the Bierstadt, Kono and Huber Patents to Yield the Invention Recited in Claims 22 or 39.

The prior art does not provide any suggestion, motivation, or teaching to combine Bierstadt, Kono and Huber to yield the invention recited in claims 22 or 39.

There is no disclosure or suggestion in Bierstadt or Kono of combining the references to produce the claimed invention. There is no disclosure or suggestion that using

the images of Kono with the 23mm gap would work in the stereoscope of Bierstadt. In fact, Bierstadt discloses abutting images which are viewed with prismatic lenses (a). Even if the references were improperly combined, the device user would not work since the Kono images with the 23 mm gap would not fuse properly using the Bierstadt viewer. Therefore, the user would not be able to see a proper fused image if the Kono images with the 23mm gap was used in the Bierstadt device.

As in In re Dembiczak discussed above, the Examiner is using hindsight to combine the Bierstadt and Kono patents. To prevent an Examiner from falling into the hindsight trap, the Examiner must point to teaching in the prior art that suggests, motivates, or teaches the claimed combination. In re Dembiczak, 50 USPQ2d at 1618. The facts of In re Dembiczak were discussed in detail to show that the Federal Circuit strictly requires such a suggestion, motivation, or teaching. Further, the particular facts of these cases are illustrative of the level of suggestion, motivation, and teaching that is required to combine references and make an obviousness rejection. Such teaching is absent from Bierstadt and Kono.

The viewer in Kono also does not have any means of interocular adjustment of lenses of occluding apertures. Kono further does not disclose or suggest that the lenses can be adjusted to visually merge the content to provide left and right peripheral monocular fields of two dimensional content and central monocular stereo field of three dimensional content as claimed. See Attachments XIV through XIX in Exhibit B. In addition, Kono does not disclose or suggest a viewer pivotal chassis for coupling the content to a viewer as claimed.

The Examiner is also clearly using hindsight to combine Huber with Bierstadt and Kono. Huber does not disclose or suggest a content portion or all, let alone a content portion which includes a left peripheral monocular field, a left monocular stereo field, a right monocular stereo field, and a right peripheral monocular field as claimed in claim 22 and 39. Huber does not disclose that the left and right lenses and left and right occluding apertures are adjustable to visually merge the content to enable perception of three fields as claimed. In addition, Huber does not disclose or suggest any type of viewer pivotal chassis to couple the viewer to a content portion. Instead, Huber discloses only a pair of glasses to wear on the user's face. The lenses (a) in Bierstadt are fixed lenses. There is no disclosure or suggestion in Bierstadt or Huber of combining the fixed lens system of Bierstadt with the adjustable glasses worn on the user's face to produce the present claimed invention.

Once again, without the disclosure of the present patent application as a blueprint, one of ordinary skill in the art would not have been motivated to combine Huber

with Bierstadt and Kono to yield the invention recited in claims 22 and 39. In In re Dembiczak, the prior art taught bags having jack-o'-lantern faces and, of course, conventional plastic trash bags. Even though the prior art taught all of the individual components, the Federal Circuit found that the prior art did not motivate one of ordinary skill in the art to combine the cited references and yield the claimed invention. In re Dembiczak, 50 U.S.P.Q.2d at 1618.

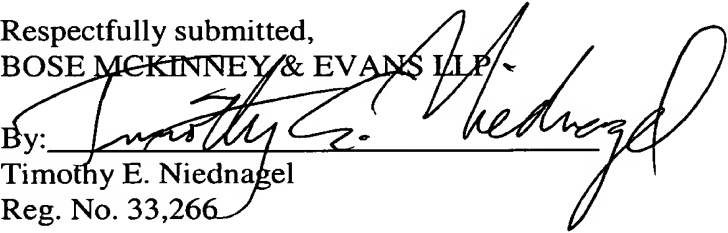
To avoid conducting an hindsight analysis, the Federal Circuit requires an Examiner to point out the suggestion, motivation, or teaching in the prior art that would have led one of ordinary skill in the art to make the claimed invention. In re Dembiczak, 50 U.S.P.Q.2d at 1618. **The Examiner in the subject application has not and cannot point to any such suggestion, motivation, or teaching in the prior art.**

For at least these reasons, Applicant submit that independent claims 22 and 39 patentably define the invention over the combination of Bierstadt, Kono and Huber. Accordingly, Applicant submit that independent claims 22 and 39 are in condition for allowance. Such action is respectfully requested.

The examiner has used similar hindsight reconstruction to reject the dependent claims of the present application. The examiner has found elements recited in Applicant's claims in a plurality of different references and then simply stated it would have been obvious to combine these references without pointing to any disclosure or suggestion within the references themselves of making such combination. Accordingly, Applicant submit that claims 22-42 and are in condition for allowance. Such action is respectfully requested. Additional details of differences between the claimed structure and the cited references are disclosed in detail in Exhibit B.

In the event that a further extension of time under 37 C.F.R. § 1.136 is deemed necessary or appropriate for the timely filing of this Request, Applicant hereby petitions for such extension of time and hereby authorizes charging the small entity fee for such petition to Deposit Account No. 02-3223 with reference to Matter 11934-5.

Respectfully submitted,  
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